

REMARKS

Claims 1-30 are pending. Favorable consideration is respectfully requested. At the outset, Applicants thank Examiner Webman for the helpful suggestions in the outstanding Office Action and for indicating that Claims 12-18 are allowable.

The rejection of Claims 1-11, 19-24, 26, and 28-29 under 35 U.S.C. § 103(a) over Ribier et al. is traversed below.

Ribier et al. discloses, at best, a composition containing cubic gel particles and methods of making the same (See abstract, column 1, lines 41-49, column 8, lines 43-63). Further, Ribier et al. discloses that the composition may have cosmetic, dermatological, or pharmaceutical use (see column 9, lines 11-14). However, nowhere in Ribier et al. can it be found that there exists any disclosure or suggestion that cubic gel particles can be used in a method of **1) protecting keratin materials from the harmful effects of pollution** by topically applying **2) an effective amount** of cubic gel particles to the keratin materials.

In direct contrast, the present invention relates to a method of **1) protecting keratin materials from the harmful effects of pollution** by topically applying **2) an effective amount** of cubic gel particles to the keratin materials.

Applicants respectfully thank the Office for recognizing that Ribier et al. fails to disclose a method of **1) protecting keratin materials from the harmful effects of pollution** by topically applying **2) an effective amount** by topically applying **2) an effective amount** of cubic gel particles to the keratin materials. This is evidenced in the fact that the Office has not rejected the claims under 35 U.S.C. § 102.

In view of the above, the Office has allegedly found motivation within Ribier et al. that would suggest to the skilled artisan reading its disclosure to adjust the disclosure therein towards the claimed invention. The Office has provided Applicants with three specific

disclosures in Ribier et al. that allegedly provide such motivation: 1) the Abstract, 2) column 1, lines 21-36, and 3) column 1, lines 16-18. However, Applicants have reviewed these specific disclosures and have found merely the disclosure of a dermatological composition and a method of making the same, not a method of **1) protecting keratin materials from the harmful effects of pollution** by topically applying **2) an effective amount** of cubic gel particles to the keratin materials, therein.

In view of these disclosures within Ribier et al., the Office submits that it has fulfilled its burden of providing a *prima facie* case of obviousness with respect to the claimed invention. Applicants respectfully suggest that the Office is putting the cart before the horse.

First, before a *prima facie* case of obviousness is established, the Office must provide Applicants where motivation lies within the reference relied upon to adjust the disclosure therein towards the Applicants claimed invention. As stated above, Ribier et al. discloses, at best, a composition containing cubic gel particles and methods of making the same (See abstract, column 1, lines 41-49, column 8, lines 43-63). Further, Ribier et al. discloses that the composition may have cosmetic, dermatological, or pharmaceutical use (see column 9, lines 11-14). However, nowhere in Ribier et al. can it be found that there exists any disclosure or suggestion that cubic gel particles can be used in a method of **1) protecting keratin materials from the harmful effects of pollution** by topically applying **2) an effective amount** of cubic gel particles to the keratin materials.

In light of the above, Ribier et al. clearly fails to disclose or suggest all limitations of the claimed invention as required by the MPEP (see § 2143.03 and the enclosed copy of *In re Royka* 180 USPQ 580 (CCPA 1974)). Accordingly, the above-mentioned reference clearly fails to anticipate the claimed invention, much less suggest it. Additionally, it has not been pointed out to the Applicants as to where any specific motivation lies within any of the

above-mentioned references that would motivate the skilled artisan reading the same to modify the process disclosed therein towards the claimed invention.

In light of the above, it appears as if the Office is relying on the Applicants disclosure to supply motivation to modify the disclosure of Ribier et al. to arrive at the claimed invention, especially since the Office admits that the suggestion and/or motivation in part comes from page 1, lines 16-18, of Applicants specification. More specifically, the Office admits that it is utilizing the Applicant's own specification against them as stated at page 2, lines 12-15, of the Office Action that:

“Applicants stipulate pollutants such as ozone, carbon monoxide, nitrogen oxides, and sulfur dioxides. . .”

However, this is clearly improper according to a recent decision (enclosed) by the U.S. Federal Courts in *In re Lee* (61 USPQ2D 1430 (CA FC 2002)). The *Lee* Court indicated that the Office must provide specific motivation, hint, or suggestion, **found in the references relied upon** to support a *prima facie* case of obviousness. In the present case, the Office clearly relies on the present specification for motivation, which is clearly forbidden according to the *Lee* Court. In light of this decision, Applicants respectfully request the Office not to use the present specification as a guidepost to combine the disparate disclosures of the cited references (see the enclosed decision in *In re Vaeck* 20 USPQ 2d 1438).

In light of the above, no *prima facie* case of obviousness can possibly exist over any combination of Ribier et al. Accordingly, withdrawal of these grounds of rejection is respectfully requested.

Further, Applicants note that in order for the Office to make additional leaps towards

an alleged *prima facie* case of obviousness, the Office characterizes that all of ozone, carbon monoxides, nitrogen oxides, and sulfur dioxides are known as oxidizing agents, yet provides no support whatsoever for this conclusion. Much more importantly, there is not one indication found in Ribier et al. of a method to treat the harmful effect of these, much less that all inherently are oxidizing agents. However, the Office has provided no proof of this. Rather, the Office is using Applicants' disclosure against them where the Applicant's disclose pollutants such as ozone, carbon monoxide, nitrogen oxides, and sulfur dioxides. As noted by the court in *In Re Ulrich*, 666 F.2d 578, 581, 212 USPQ 323 (CCPA 1981), the mere fact that a certain thing may result from a given set of circumstances is not sufficient to prove inherency. Inherency may not be established by probabilities or possibilities. Something that is inherent must inevitably be the result each and every time.

It is by now well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office. See *In Re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984), quoting *In Re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA, 1967).

As noted by the Board of Patent Appeals and Interferences in *Ex parte Skinner*, 2 USPQ 2d 1788, before an Examiner can switch the burden of proof of showing non-inherency to the Applicant, the Office must provide some evidence or scientific reason to establish the reasonableness of the Office's belief that the functional limitation is an inherent characteristic of the prior art. In this case, the Office has provided no such evidence, because the Examiner has not provided an adequate showing that the composition according to Ribier et al. pollutants such as ozone, carbon monoxide, nitrogen oxides, and sulfur dioxides are oxidizing agents each and every time.

Most importantly, inherency is utilized to support a *prima facie* case of anticipation,

not a *prima facie* case of obviousness and the present rejection is based upon an assertion of a *prima facie* case of obviousness. Accordingly, the Office can not rely on inherency to support a *prima facie* case of obviousness, especially since the Office is required to provide explicit disclosure within the references relied upon that provide motivation towards the claimed invention. By definition, inherency is an admission that no explicit disclosure exists therein the cited references.

In light of the above, Ribier et al. fails to disclose that pollutants such as ozone, carbon monoxide, nitrogen oxides, and sulfur dioxides are oxidizing agents each and every time which is required to establish a *prima facie* case of anticipation based on inherency (see In Re Ulrich discussed above). Further, the rejection is asserted to be one of obviousness, not anticipation, where motivation must be supplied by explicit disclosures of the references relied upon and must not be provided by inherency if inherency even existed. Therefore, the suggestion that a burden lies on the Applicant to refute a *prima facie* case of obviousness is putting the cart before the horse because no *prima facie* case of obviousness can possibly be sustained in light of the above reasons.

If Applicants are mistaken in their above comments, then the Office may be relying on the level of skill in the art to replace the lack of specific motivation in the cited reference. This too is inappropriate absent evidence that must be provided to the Applicant by the Office demonstrating such levels or absent an Examiner's Declaration. The Office is invited to provide such evidence or the above-mentioned Examiner's Declaration in a subsequent non-Final Office Action.

Still further, Ribier et al. fails altogether to suggest a method of **protecting keratin materials from the harmful effects of pollution** because there is clearly no consideration whatsoever by Ribier et al. as to what an effective amount of cubic gel particles is required to

protect keratin materials from the harmful effects of pollution. Ribier et al. is purely concentrated on an amount of cubic gel particles that is required to stabilize a dispersion composition containing the same (see column 8, lines 43-63). One reading Ribier et al. would only be motivated to maintaining a stable dispersion composition by adjusting the effective amount of cubic gel particles that is effective to stabilize the claimed dispersion, which has not been shown at all by the Office to even come remotely close to the effective amount that is required to be utilized as claimed to **protect keratin materials from the harmful effects of pollution.**

In light of the above, Applicants respectfully submit that the Office has failed to meet its burden to supply a *prima facie* case of obviousness based solely on the cited reference. Further, the Office is once again respectfully requested not to use the present specification as a guidepost to combine the disparate disclosures of the cited references (see the enclosed decision in *In re Vaeck* 20 USPQ 2d 1438). Accordingly, withdrawal of this ground of rejection is respectfully requested.

Applicants respectfully submit that the present application is now in condition for allowance. Favorable reconsideration is respectfully requested. Should anything further be required to place the application in condition for allowance, the Office is requested to contact the undersigned by telephone.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER AND NEUSTADT, P.C.



Richard L. Treanor
Registration No. 36,379
Attorney of Record



22850

Thomas W. Barnes III
Registration No. 52,595

(703) 413-3000
(703) 413-2220 (fax)
NFO:RLT:TWB/bwt
I:\atty\Twb\208593us-am.wpd